



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/704,755	11/03/2000	Hideaki Furukawa	35.C10563 REI	4371

5514 7590 11/17/2005

FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

PAN, DANIEL H

ART UNIT	PAPER NUMBER
----------	--------------

2183

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/704,755	<b>Applicant(s)</b> FURUKAWA, HIDEAKI	
	<b>Examiner</b> Daniel Pan	<b>Art Unit</b> 2183	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-86 and 138-153 is/are pending in the application.
- 4a) Of the above claim(s) 87-137 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-86 is/are allowed.
- 6) ☒ Claim(s) 138-153 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 08/413,432.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. Claims 1-86, 138-153 remain for examination. Claims 87-137 have been canceled.
2. Claims 138-153 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakahara et al. (5,172,244) in view of Sakata (4,905,098).
3. As to the amended feature of the recognition of the trouble count value indicating the update number of troubles until the predetermined value of print count in claim 138, Sakata also included a trouble count value indicated the number of troubles (see the jam counter) until a predetermined print count [particular papers] (see the key counter operable as jam counter and for counting particular papers in addition to the total counter in col.11, lines 7-23). It is recognizable by one of ordinary skill in the art that that counting of particular papers must included a predetermined count value for the particular papers such as print number of papers, otherwise , the updated count would go indefinite, which was mostly unlikely. Therefore, Sakata's jam counter must have a predetermined print count value, and Sakata did suggest a predetermined count value by disclosing the indication of the particular number of papers.
4. The rejections to claims 138-153 are maintained and incorporated by the reference the last Office action on 03/16/05.
5. The response filed by applicant on 07/18/05 has been fully considered but is not persuasive.
6. In the remarks, applicant argued that :

Art Unit: 2183

- a) Nakahara did not teach the transmission of trouble count if the print count is updated to a predetermined value;
- b) Sakata failed to disclose how the counters are used to count jams.

7. As to a) Nakahara did not specifically showed the transmission of trouble count if the print count is updated to a predetermined value as claimed. However, Sakata disclosed Sakata also included a trouble count value indicated the number of troubles (see the jam counter) until a predetermined print count [particular papers] (see the key counter operable as jam counter and for counting particular papers in addition to the total counter in col.11, lines 7-23). It is recognizable by one of ordinary skill in the art that that counting of particular papers must included a predetermined count value for the particular papers such as print number of papers, otherwise, the updated count would go indefinite, which was mostly unlikely. Therefore, Sakata's jam counter must have included a predetermined print count value, and Sakata did suggest a predetermined count value by disclosing the indication of the particular number of papers. It would have been obvious to one of ordinary skill in the art to use Sakata in Nakahara for including the trouble counter if the print count was updated to a predetermined value as claimed because the use of Sakata could provide Nakahara the control capability to accept a predetermined number of prints in response to specific set of conditions of the apparatus to track the number of prints with the number of the troubled copies, such as the jammed paper taught already by Sakata, and therefore, enhancing the processing adaptability of Nakahara, and it could be done by

Art Unit: 2183

configuring the jam counter of Sakata with modified counter parameter (e.g. the counter R/W port width) into Nakahara so the jam counter could be recognized by Nakahara , and because Nakahara also disclosed a print count and update count (see the set number and count number in col.3, lines 56-64, col.6, lines 9-39), which was a suggestion of the need for providing a solution for tracing the difference between the print count and the update count in order to achieve the enhanced adaptability , and in doing so, provided a motivation.

8. As to b), Sakata already taught how the counters are used for jam counter the same way as the counter for counting the particular papers in addition to total number of papers (see col.11, lines 7-23).

9. Claims 1-86 are allowable over the art of record as recited in previous action.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2183

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Pan whose telephone number is 703 305 9696, or the new number 571 272 4172. The examiner can normally be reached on M-F from 8:30 AM to 4:00 PM.

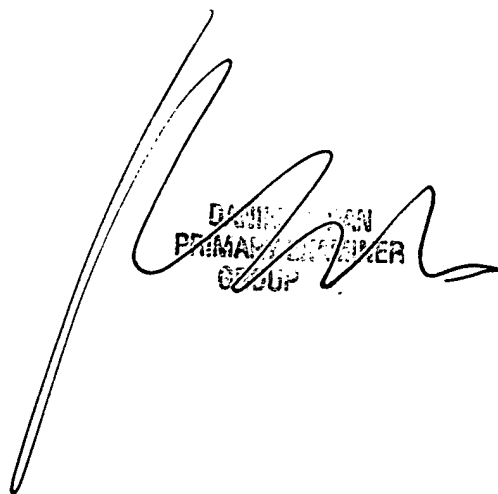
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chan, can be reached on 703 305 9712, or the new number 571 272 4162. The fax phone number for the organization where this application or proceeding is assigned is 703 306 5404.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

***21 Century Strategic Plan***

Application/Control Number: 09/704,755  
Art Unit: 2183

Page 6



Handwritten signature and official stamp. The stamp text is: DURING THE  
PRIMAVERA  
GROUP